

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas Zelinski et al.

Application No.: 10/541,427

Confirmation No.: 6584

Filed: July 5, 2005

Art Unit: 1651

For: METHODS FOR PRESERVING AND/OR
STORING CELLS HAVING A NITRILASE OR
NITRILE HYDRATASE ACTIVITY

Examiner: Hanley, Susan Marie

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed September 13, 2007, Applicants provisionally elect Group I, claims 14-21 and 25-26, the microorganism *Alcaligenes*, and a recombinant protein or enzyme, with traverse. Applicants respectfully traverse and strongly urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the invention of Groups I-III do not relate to a “special technical feature” which defines a contribution over the prior art, citing Yamada *et al.* (US 4,900,672, hereinafter “Yamada”). Applicants respectfully disagree that the inventions of the present application do not make a contribution over the reference cited by the Examiner.

As stated in the specification and repeated in the claims, the invention relates to a method for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity.

See Specification at page 1 and claim 1. Thus, the common technical feature shared by all claims of Groups I-III is preserving and/or storing a microorganism which exhibits at least one nitrilase enzyme activity. As the Examiner correctly characterized, which is confirmed by the international Examiner's characterization, Yamada discloses a method for preserving the nitrile hydratase activity in *Pseudomonas*. See Office Action at page 2 and International Preliminary Examination Report, Box V, item 3.1 under "Citation and Explanations," a copy thereof is attached herewith for the Examiner's easy reference. Nevertheless, Yamada does not teach a method for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity. Nitrilase and nitrile hydratase are two different enzymes. See Specification at page 1, lines 22-26 and page 9, line 39 through page 10, line 10. Thus, Yamada does not teach the special common technical feature of the present application. Accordingly, it is clear that the present invention is distinct over Yamada in view of the different enzyme involved, which further defines a contribution over the prior art. Applicants respectfully request that the restriction requirement be reconsidered and all the claims be examined in one application.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine all Groups together. As stated in § 803 of the M.P.E.P. "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added). Accordingly, Applicants respectfully submit that the restriction requirement should be withdrawn even under restriction practice.

For these reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn entirely.

The International Examiner Found Unity of Invention

Furthermore, unity of invention was found during the International stage. As shown in the International Preliminary Examination Report and International Search Report, all claims were searched and examined together. Thus, application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists. Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, for this additional reason, there would be no undue burden on the Examiner to examine all Groups in one application.